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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,109	05/31/2006	Wolfgang von Deyn	BASF.10156WOUS	5188
45473	7590	03/13/2008	EXAMINER	
HUTCHISON LAW GROUP PLLC PO BOX 31686 RALEIGH, NC 27612				HOLLOMAN, NANNETTE
ART UNIT		PAPER NUMBER		
		4131		
MAIL DATE			DELIVERY MODE	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/581,109	VON DEYN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	NANNETTE HOLLOWMAN	4131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 15-36 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 15-36 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____ .                                     |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>30 Mar 2007</u> .   | 6) <input type="checkbox"/> Other: ____ .                         |

## **DETAILED ACTION**

The Preliminary Amendment filed on May 31, 2006 cancelling claims 1-14 and adding new claims 15-36 has been received and entered.

### ***Election/Restrictions***

Applicant's election with traverse of Group I, claims 15-17, 19-20 and 23-26 in the reply filed on February 11, 2008 is acknowledged. Upon further consideration, examiner has withdrawn the restriction requirement. Claims 15-36 are pending and are the subject of this Office Action. This is the first Office Action on the merits of the Claims.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to

whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 15, 18, 27, and 30 recites the broad recitation “pests”, and the claim also recites “non-crop pest” which is the narrower statement of the range/limitation.

Claims 18 and 21-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “non-living organic materials” in claim(s) 18 and 21-22 is used by the claim to mean “trees, plant and animal”, while the accepted meaning is “not having characteristics of life.” The term is indefinite because the specification does not clearly redefine the term.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim(s) 15-17, 19-20, and 23-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Furch et al. (EP 0 604 798 A1, as cited by the applicant). Furch et al. teaches a method as claimed for controlling non-crop pests comprising contacting the pests or food supply, habitat, breeding grounds or their locust with a pesticidally effective amount of the same compound as claimed. Furch et al. discloses the control of insect pests to include crop pest and non-crop pest (claims).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claim(s) 18, 21-22, 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furch et al. as applied to claim(s) 15-17, 19-20, and 23-26 above, and further in view of Drabb, Jr. (U.S. Patent # 4152436). Furch et al. teaches a method as claimed for controlling non-crop pests comprising contacting the pests or food supply, habitat, breeding grounds or their locust with a pesticidally effective amount of the same compound as claimed. Furch et al. discloses the control of insect pests to include crop pest and non-crop pest (claims). Furch et al. also discloses the protection of harvested crops that includes the protection of non-living organic materials as disclosed by applicant to include mono-, oligo- or polysaccharides (page 6, lines 20-23).  
Furch et al. does not teach treatment to include the protection of non-living organic materials such as houses and protection of animals such as human and livestock by contacting the food supply, habitat, and breeding grounds of the non-crop pest with the compound. Nor does Furch et al. teach the use of the compound as bait with an attractant.  
Drabb, Jr. teaches the use of a compound to control crop pest and non-crop pest to include Lepidopterous, Orthopterous, Isopterus and Dipterous insects. Drabb, Jr. discloses the method of treatment including contacting the insect, their habitat, and/or their food supply with an effective amount of the compound. Treatment also includes the protection of non-living organic materials such as houses and protection of animals such as human and livestock by contacting the food supply, habitat, and breeding

grounds of the non-crop pest with the compound. Drabb, Jr. also disclosed the use of the compound as bait with an attractant.

It would have been *prima facie* obvious to one skilled in the art at the time of the invention, to use the claimed compound as taught by Furch et al. with the methods as taught by Drabb, Jr. to control crop pest and non-crop pest to include Lepidopterous, Orthopterous, Isopterus and Dipterous insects. Drabb, Jr. discloses the method of treatment including contacting the insect, their habitat, and/or their food supply with an effective amount of the compound. Treatment also includes the protection of non-living organic materials such as houses and protection of animals such as human and livestock by contacting the food supply, habitat, and breeding grounds of the non-crop pest with the compound. Drabb, Jr. also disclosed the use of the compound as bait with an attractant. A person skilled in the art at the time of the invention would have motivated to use the methods taught by Drabb, Jr. with the compound as taught by Furch et al.

### ***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANNETTE HOLLOMAN whose telephone number is (571) 270-5231. The examiner can normally be reached on Mon-Fri 730am-500pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867 or Cecilia Tsang on 571-

272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JANET L ANDRES/  
Supervisory Patent Examiner, Art Unit 4131

/NANNETTE HOLLOMAN/  
Examiner, Art Unit 4131